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Paper No. 27

COPY MAILED

JUN 3 0 2003

In re Application of
Kenneth N. Bates
Application No. 09/628,942
Filed: July 28, 2000
Title of Invention: ACOUSTIC WAVE
IMAGING APPARATUS AND METHOD

: **OFFICE OF PETITIONS**
: DECISION DISMISSING
: PETITION
:
:
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This is a decision on the petition, filed June 6, 2003, under 37 CFR 1.137(a), to revive the above-identified application.

The petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time (and fee) under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled, "Renewed Petition under 37 CFR 1.137(a)"

This application became abandoned for failure to timely and properly reply to the final Office action, mailed October 2, 2002, which set a shortened statutory period of three months for reply. Petitioner filed an Amendment in response to the final Office action on December 30, 2002. That response, however, was not deemed to place the application in condition for allowance, as was stated in an Advisory Action mailed to Petitioner, on January 6, 2003. Petitioner filed a Request for Reconsideration, along with a request for a one (1) month extension of time to reply to the final Office Action pursuant to 37 CFR 1.136(a). In response to the Request for Reconsideration, a second Advisory Action was mailed on February 26, 2003. That Advisory Action informed Petitioner that claims 24 - 38 were allowed, but that the Amendment was not in compliance with 37 CFR 1.173(c). Petitioner filed a response to the February 26, 2003 Advisory Action on April 2, 2003; however, that response failed to place the application in condition for allowance because Petitioner still had not complied with 37 CFR 1.173. Petitioner was so notified in a third Advisory Action, mailed on April 16, 2003. Accordingly, this application became abandoned on April 3, 2003. A Notice of Abandonment was mailed on May 5, 2003.

In response to the abandonment, Petitioner files the instant petition wherein Petitioner avers that the Patent Office caused an unnecessary two month delay by initially disallowing the claims in the December 30th Amendment, and subsequently allowing the claims (in response to the Request for Reconsideration). Petitioner acknowledges that the second Advisory Action addressed the form of the Amendment, and that he was unsure of what the Examiner was requesting. The response filed April 2, 2003 "contained multiple variations of the requested supplemental paper - evidencing confusion as to the format of the appropriate response." Petition p.2. Because the delay was in part a result of Office error, and in part due to a good-faith misunderstanding of Petitioner, Petitioner avers the delay was unavoidable.

Applicable Law

Petitioner advised that decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Moreover, a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (1) the applicant's reliance upon oral advice from Office employees; or (2) the Office's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985); see also In re Colombo, Inc., 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994) (while the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction) (Emphasis supplied).

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by (1) a proposed response to continue prosecution of the abandoned application, or filing of a continuation application, unless either has been previously filed; (2) the petition fee required by 37 CFR 1.17(l); (3) an adequate verified showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) as required pursuant to 37 CFR 1.137(c). This petition lacks items (3) above.

Analysis

Petitioner is directed to the MPEP, section 711.02, which reads:

37 CFR 1.135(a) specifies that an application becomes abandoned if applicant 'fails to reply' to an office action within the fixed statutory period. This failure may result either from (A) failure to reply within the statutory period, or (B) insufficiency of reply, i.e. failure to file a 'complete and proper reply, as the condition of the case may require' within the statutory period (37 CFR 1.135(b)).

This section explains that abandonment occurs when petitioner fails to timely and properly reply to the outstanding Office action.

Petitioner is further directed to 37 CFR 1.135(b), Abandonment For Failure to Reply Within Time Period, which reads:

Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

This section is further clarified in the MPEP, which provides

[f]or example, as 37 CFR 1.116 and 1.135(b) are manifest that proceedings concerning amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, a delay is not 'unavoidable' when the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action.

MPEP S 711.03(c).

The evidence has been considered, but is not persuasive that the delay was unavoidable. It is noted initially that it is the Applicants responsibility to file a complete and proper reply in the first instance. Petitioner seeks to differentiate the form over the substance of the reply; however, the response must be both timely and proper. It was the form of the Amendment that failed to place the application in condition for allowance. Petitioner admits that he was confused as to the response required. However, a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (1) the applicant's reliance upon oral advice from Office employees; or (2) the Office's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action.

As iterated in *In re Colombo, Inc.*, 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994), while the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction. The application became abandoned because Petitioner failed to file a complete and proper reply as the condition of the application required.


Accordingly, the petition under 37 CFR 1.137(a) is dismissed.

ALTERNATE VENUE

Petitioner is strongly encouraged to file a petition under 37 CFR 1.37(b). A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: (1) the required reply (unless previously filed), which may met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute, but must be the payment of the issue fee or any outstanding balance thereof in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof; (2) the petition fee required by 37 CFR 1.17(m), which is currently \$640.00 ; (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) a terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)).

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-0014.


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Office of Petitions